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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,755	02/12/2001	David W. Cox JR.	40091-10018	8425
7590	12/17/2003		EXAMINER	
Patent and Trademark Docket Clerk RYNDAK & SURI Suite 2630 30 N. LaSalle Street Chicago, IL 60602			ST CYR, DANIEL	
			ART UNIT	PAPER NUMBER
			2876	
			DATE MAILED: 12/17/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/781,755	COX, DAVID W.	
Examiner	Art Unit		
Daniel St.Cyr	2876		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### **Status**

## Disposition of Claims

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/22/03 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5, 6, 14, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ausrus, DE Patent No. 2844242.

Ausrus discloses monitoring system protecting goods against shoplifting comprising: a label attached to a retail item, said label lacking a post-purchase machine-readable indicia; a point of sale encoding device (cancellation device) provided a post purchase indicia to the label during purchase by the customer; and a detecting device (monitoring device) for analyzing the label to determine whether the post-purchase machine-readable indicia is present (see the abstract).

Re claims 2, 3, the post-purchase machine-readable indicia is machine-readable only and invisible (electronic circuit is used).

Re claim 5, the encoding device provides the machine-readable post-purchase indicia electrically (electric circuit) via a changeover frequency.

Re claim 6, the label is either paper or plastic (see figure 4).

The limitations of claims 16-18 have been met above.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 7, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ausrus in view of Johnsen et al, US Patent No. 5,109,153. The teachings of Ausrus have been discussed above.

Ausrus fails to disclose or fairly suggests that the post-purchase indicia is visible under infrared light or ultraviolet radiation and that the label is a bar code label having a plurality of layers.

Johnsen et al disclose a flash imaging and voidable articles comprising: a bar code label 13 having a bar code 14, the label has a plurality of layers containing a mixture of dry silver and transparency bases material, and the label contains information that becomes visible when exposed to infrared light.

In view of Johnsen's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Ausrus to incorporate the well known bar code label of Johnsen as an alternate means for identifying and verifying

purchase items. Such modification would provide greater flexibility wherein the post purchase indicia could be encoded electronically and optically, which would make the system more versatile and more convenient. Therefore, it would have been obvious extension as taught by Ausrus et al.

6. Claims 9-13, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beller et al, US Patent No. 5,602,377, in view of Johnsen et al, US Patent No. 5,109,153.

Beller et al disclose a bar code dataform scanning and labeling apparatus and method comprising: a label 12 associated with a retail item 14, said label lacking a post purchase machine-readable indicia, a point of sale encoding device 10 providing a machine-readable post-purchase indicia 16 associated with the label during the purchase by a customer; and a detecting means is inherently included to detect the post-purchase indicia when the item is returned, the post purchase indicia is machine-readable only, the encoding device provides said machine-readable indicia optically, the label is selected from paper, plastic etc., the label is comprised of a plurality of layers (data layer, adhesive layer etc.), a refund is conditioned upon detecting the post-purchased indicia, the post purchase indicia identifies the store where said retail item was sold and the payment method. (see figures 1, 4, 5; col. 6, line 26+).

Beller et al disclose that the bar code may be printed in invisible ink, but fail to disclose or fairly suggest that the invisible code is printed on the label for indicating the post-purchase indicia.

Johnsen et al disclose a flash imaging and voidable articles comprising: a bar code label 13 having a bar code 14, the label has a plurality of layers containing a mixture of dry silver and

transparency bases material, and the label contains information that becomes visible when exposed to infrared light (see figures 1-3 and col. 3, line 6+).

In view of Johnsen et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Beller et al to employ the well known label of Johnsen et al in lieu of the current label for identifying and verifying returned merchandises. Such modification would make the system more effective, more economical, and more practical wherein the label of the purchase items could just be easily exposed to the an infrared source to reveal post-purchase indicia. Regarding to erasing the invisible code or removing the label from the returned items, once the returned items are verified to be in condition for re-circulation, erasing the code would have been obvious so that the item could be properly processed and made available for sale. Therefore, it would have been an obvious extension as taught by Beller et al.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Halperin et al, US Patent No. 6,226,619, disclose a method for preventing counterfeiting of high price wholesale and retail items.

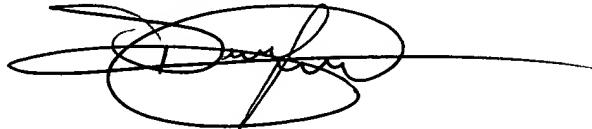
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7721.

Art Unit: 2876

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr  
Primary Examiner  
Art Unit 2876

A handwritten signature in black ink, appearing to read "Daniel St.Cyr", is written over a horizontal line. The signature is fluid and cursive, with a large, stylized "D" at the beginning.

DS

December 8, 2003